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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/535,804	03/28/00	MURATA	T 1803-124A

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VINCENT M DELUCA  
ROTHWELL FIGG ERNST & MANBECK  
SUITE 701 EAST  
555 13TH STREET NW  
WASHINGTON DC 20004

EXAMINER

DOLINAR, A

ART UNIT

PAPER NUMBER

3747

DATE MAILED: 02/09/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

**Application No.**

09/535,804

**Applicant(s)**

MURATA, TAKASHI

**Examiner**

Andrew M. Dolinar

**Art Unit**

3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obata et al in view of Mizikovsky. Obata et al discloses the claimed invention except for the specific use of a digital telephone and the telephone number detecting means. The claimed memory storage features are taught, for example, at column 9, lines 18-44. Deletion of previously stored matching numbers per claim 15 is implied. Telephone number storage unit 11a-2 corresponds to the registering memory of claim 1 and the second memory of claim 2. Mizikovsky teaches that it is known to obtain caller identification information from transmissions in a digital cellular telephone system. See column 10, lines 35-54. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the call storing system of Obata et al so as to obtain caller identification information from transmissions in a digital cellular telephone system, as taught by Mizikovsky, in order to provide a call storing apparatus which is capable of operating in existing digital telephone systems and to eliminate the need for the caller to enter the telephone number. Caller identification would inherently occur before a speech path is established.

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***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Mizikovsky expressly discloses the use of digital communication equipment for obtaining caller identification information as an alternative to analog communication equipment beginning at column 10, line 35. See Fig. 4. Therefore, the modification of Obata et al as stated above is suggested by the prior art. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982). Applicant's argument that there is no motivation to make the conversion is based on conjecture.

At column 10, lines 35-54, Mizikovsky states:

"FIG. 4 schematically illustrates the format of an "alert with information" message that is transmitted on the forward digital traffic channel in a digital cellular telephone system. Here too, the message is transmitted as a succession of transmission frames comprising a packet 400, with each packet containing identifying data plus information words. As shown, the identifying data in a packet 400 includes message identifying bits 402, followed by bits 404 further identifying the type of alert, followed by useful message information 406. When packet 400 is included in an "alert with information" message, the message identifying bits 402 identify this message as an "alert with information" message. Bits 404 identify the type of "alert with information" message; and in the present example, the type of "alert with information" message is an incoming call with calling party identifying data. Word 406 includes a portion of that calling party identifying data, such as a plurality of digits included in the calling party telephone number, a plurality of alphanumeric characters that may be used to identify the calling party, etc."

This appears to be essentially the same way that applicant obtains caller identification data.

The telephone resulting from the above modification would inherently detect telephone number information before a speech path is established to the extent claimed, i.e. before the telephone is answered. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. See MPEP § 2111.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Dolinar whose telephone number is (703) 308-1948. The examiner can normally be reached on Mon. - Thu. (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on (703) 308-1946. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7766 for regular communications and (703) 308-7766 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

  
Andrew M. Dolinar  
Primary Examiner  
Art Unit 3747

AMD  
February 8, 2001